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EXAMINER
PAULA, C

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

		Application No.	Applicant(s)
Office Action Summary		09/209,162	BAKER, MICHELLE
		Examiner	Art Unit
		CESAR B PAULA	2776

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed
   after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will
   be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this
   communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on <u>03 July 2000</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

   a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

   1.☐ received.

   2.☐ received in Application No. (Series Code / Serial Number) _____ .

   3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)   18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   19)☐ Notice of Informal Patent Application (PTO-152)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   20)☐ Other: .

DETAILED ACTION

1.   This action is responsive to the amendment filed on 7/3/2000.

This action is made non-final.

2.   In the amendment, claim 25 has been added. Claims 1-25 are pending in the case.

Claims 1, 13, 20, and 25 are independent claims.

3.   The rejections of claims 1-2, and 10-11, and 14-20 under 35 U.S.C. 102(a) as being

anticipated by Fleming, Internet Explorer 4 6-In-1 (pages 182-185, 201-205, 210-217, 265-271,

11/3/97)1-24 have been withdrawn as necessitated by the amendment.

4.   The rejections of claims 3-4, and 8-9, 12, 15-16, and 21-22 under 35 U.S.C. 103(a) as

being unpatentable over Fleming, Internet Explorer 4 6-In-1, in view of over Wolf et al (Pat. #

5,818,447, 10/6/1998, filed on 6/6/1996) have been withdrawn as necessitated by the

amendment.

5.   The rejections of claims 5-7, 17-19, and 23-24 under 35 U.S.C. 103(a) as being

unpatentable over Fleming, Internet Explorer 4 6-In-1, in view of over Hong et al (Pat. #

5,710,883, 1/20/1998, filed on 3/10/1995) have been withdrawn as necessitated by the

amendment.

Drawings

6.   This application has been filed with informal drawings which are acceptable for

examination purposes only. Formal drawings will be required when the application is allowed.

Specification

7.   The objection to the title has been withdrawn.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation: "....creating an other than text portion of a document" is unclear.

10.   Claim 1 recites the limitation "...encoding said representations.....". There is insufficient antecedent basis for this limitation in the claim.

11.   Claim 3 recites the limitation "....the group consisting of a game.....". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 1-2, and 10-11, 14, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming, Internet Explorer 4 6-In-1 (pages 182-185, 201-205, 210-217, 265-271, 11/3/97), in view of Mosher, Microsoft Outlook E-Mail & Fax Guide (12/1/97).

Regarding independent claim 1, Fleming discloses: "Using Outlook Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4). Fleming fails to explicitly disclose: *a) a plurality of authoring components a first .....creating a representation of a document including other than text* . However, Mosher discloses: "...add remove information fields......" (p. 3)-- *other than text*. It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Fleming and Mosher, because Mosher teaches: ".....design forms that can do almost anything you can imagine in Outlook......" (p. 3).

Moreover, Fleming discloses: *b) encoding means for automatically encoding said representations...into an Internet-compatible email message* --"Creating a message to send through the Internet is a very simple process......" (page 201, pgph 1). In the preceding quote Fleming teaches an email authoring program to create and prepare Internet-compatible email documents.

Furthermore, Fleming discloses: *c) decoding means for automatically decoding said representations ....* --"There are many things you can do with the message that you retrieve from your mail server.....reading messages......" (page 213, pgph 1-3). In the preceding quote Fleming teaches an email authoring program to read or decode email documents.

Regarding claim 2, which depends on claim 1, Fleming discloses: *.....said plurality of authoring components include at least one installable component.* --"...Once you're done typing you message, open the Tools menu and select Spelling......" (page 203, pgph 4). In the preceding quote Fleming teaches an email authoring program which allowed a user to check the spelling with an installed spelling checking component.

Regarding claim 10, which depends on claim 1, Fleming discloses: *said encoding means and said decoding means communicate bidirectionally.... at least one of said* -- "There are many things you can do with the message that you retrieve from your mail server.....reading messages......" (page 213, pgph 1-3). In the preceding quote Fleming teaches an email authoring program which allowed a user to retrieve an email message or reply to an author or other users or readers.

Regarding claim 11, which depends on claim 1, Fleming discloses: *at least one of said authoring components includes means for recognizing whether a user is an author or a reader...* -- "There are many things you can do with the message that you retrieve from your mail server.....reading messages......" (page 213, pgph 1-3). In the preceding quote Fleming teaches an email authoring program which allowed a user to retrieve an email message or reply to an author or other users or readers.

Claim 14 is directed towards an electronic mail client for implementing the mail client found in claim 2, and is similarly rejected.

Claim 20 is directed towards a method for implementing the mail client found in claim 1, and is similarly rejected.

Claim 25 is directed towards a system for implementing the mail client found in claim 1, and is similarly rejected.

14.   Claims 3-4, and 8-9, 12, 15-16, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming, Internet Explorer 4 6-In-1, in view of Mosher as applied to claim 1 above, and further in view of Wolf et al (Pat. # 5,818,447, 10/6/1998, filed on 6/6/1996).

Regarding claim 3, which depends on claim 1, Fleming discloses: "Using Outlook

Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4).

Fleming fails to explicitly disclose: .....*said plurality of authoring components include at least*

one... of ......spreadsheet component, and a graphic component. However, Wolf et al disclose:

"...the mail note allows a separate, full-featured word processing program to display and edit the

message......" (Col. 14, lines 56-62), and "...the interfaces and techniques described herein may

be applied to incorporate other types of applications....spreadsheet program......" (Col. 23, lines

61-67). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to had combined the teachings of Fleming and by Wolf et al, because Wolf et al teach

above the implementation of full-featured application programs (word processors, spreadsheet,

drawing etc.) for display and editing an e-mail message.

Regarding claim 4, which depends on claim 1, Fleming discloses: "Using Outlook

Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4).

Fleming fails to explicitly disclose: .....*said plurality of authoring components include at least*

one... of ......database component, a presentation component..... However, Wolf et al disclose:

"...the mail note allows a separate, full-featured word processing program to display and edit the

message......" (Col. 14, lines 56-62), and "...the interfaces and techniques described herein may

be applied to incorporate other types of applications....spreadsheet program......" (Col. 23, lines

61-67). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to had combined the teachings of Fleming and Wolf et al, because Wolf et al teach:

"..allow a spreadsheet program....to display their respective documents in the view port provided

by the container mail note......" (Col. 23, lines 64-67).

Regarding claim 8, which depends on claim 1, Fleming discloses: "Using Outlook

Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4).

Fleming fails to explicitly disclose: *d) a plurality of mailbox/browser components......displaying*

mailbox contents in a different style. However, Wolf et al disclose: "...the mail note allows a

separate, full-featured word processing program to display and edit the message......" (Col. 14,

lines 56-62). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to had combined the teachings of Fleming and Wolf et al to display the *mailbox*

contents in a different style, because Wolf et al teach: "..allow a spreadsheet program....to

display their respective documents in the view port provided by the container mail note......"

(Col. 23, lines 64-67).

Regarding claim 9, which depends on claim 1, Fleming discloses: "Using Outlook

Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4).

Fleming fails to explicitly disclose: *d) a plurality of mailbox/browser components......displaying*

mailbox contents in a different style. However, Wolf et al disclose: "...the mail note allows a

separate, full-featured word processing program to display and edit the message......" (Col. 14,

lines 56-62). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to had combined the teachings of Fleming and Wolf et al to display the *mailbox*

contents in a different style, because Wolf et al teach: "..allow a spreadsheet program....to

display their respective documents in the view port provided by the container mail note......"

(Col. 23, lines 64-67).

Regarding claim 12, which depends on claim 1, Fleming discloses: "Using Outlook

Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4).

Fleming fails to explicitly disclose: *at least one of said authoring components includes means for allowing a user to create a read-only document.* However, Wolf et al disclose: "...the mail note allows a separate, full-featured word processing program to display and edit the message......" (Col. 14, lines 56-62), and "...the interfaces and techniques described herein may be applied to incorporate other types of applications....spreadsheet program......" (Col. 23, lines 61-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Fleming and Wolf et al *to create a read-only document* as it was well known in the art at the time of the invention, because Wolf et al teach: "..allow a spreadsheet program....to display their respective documents in the view port provided by the container mail note......" (Col. 23, lines 64-67).

Claims 15-16 are directed towards an electronic mail client for implementing the mail client found in claims 3-4 respectively, and are similarly rejected.

Regarding claim 21, which depends on claim 20, Fleming discloses: *....providing a plurality of document authoring components* --"Using Outlook Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4), and "...Once you're done typing you message, open the Tools menu and select Spelling......" (page 203, pgph 4). In the preceding quote Fleming teaches an email authoring program to personalize email documents using an stationary graphics, and spellchecking components among other document-authoring components.

Furthermore, Fleming discloses: "Using Outlook Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4). Fleming fails to explicitly disclose: ......*linking each of said document-authoring components with the document-encoding*

component. However, Wolf et al disclose: "...the mail note allows a separate, full-featured word processing program to display and edit the message......" (Col. 14, lines 56-62), and "...the interfaces and techniques described herein may be applied to incorporate other types of applications....spreadsheet program......" (Col. 23, lines 61-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Fleming and Wolf et al to had linked *each of said document-authoring components with the document-encoding component*, because Wolf et al teach: "..allow a spreadsheet program....to display their respective documents in the view port provided by the container mail note......" (Col. 23, lines 64-67).

Regarding claim 22, which depends on claim 20, Fleming discloses: *d) providing a document decoding component which decodes a received document......* --"Opening a message isn't the only way to read it, ...You can read through a message......" (page 213, pgph 1). In the preceding quote Fleming teaches an email authoring program which allowed a user decode or view Internet-compatible email message.

Furthermore, Fleming discloses: *c) linking the document-authoring component with the document-decoding component ......* --"Opening a message isn't the only way to read it, ...You can read through a message......" (page 213, pgph 1). In the preceding quote Fleming teaches an email authoring program which allowed a user automatically preview Internet-compatible email message.

15.   Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming, Internet Explorer 4 6-In-1.

Regarding independent claim 13, Fleming discloses: *a) a plurality of authoring components a first .....creating a representation of a document including other than text* --"Using Outlook Express, you can make all of your messages use a particular stationery......" (page 204, pgph 4). In the preceding quote Fleming teaches an email authoring program to personalize email documents using stationary graphics.

Moreover, Fleming discloses: *b) encoding means for automatically encoding said representations...* --"Creating a message to send through the Internet is a very simple process......" (page 201, pgph 1). In the preceding quote Fleming teaches an email authoring program to create and prepare Internet-compatible email documents.

Moreover, Fleming discloses: *c) decoding means for automatically decoding said representations ....* --"There are many things you can do with the message that you retrieve from your mail server.....reading messages......" (page 213, pgph 1-3). In the preceding quote Fleming teaches an email authoring program to read or decode email documents.

Furthermore, Fleming discloses "There are many things you can do with the message that you retrieve from your mail server.....reading messages......" (page 213, pgph 1-3). Fleming fails to explicitly disclose *at least one of said authoring components includes means for determining whether the user is a student or a teacher.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to had included *means for determining whether the user is a student or a teacher,* because Fleming teaches in an email authoring program which allowed a user to retrieve an email message or reply to an author—*teacher*-- or other users or *students.*

16.   Claims 5-7, 17-19, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Fleming, Internet Explorer 4 6-In-1, in view of Mosher as applied to claim 1 above, and

further in view of Hong et al (Pat. # 5,710,883, 1/20/1998, filed on 3/10/1995).

Regarding claim 5, which depends on claim 1, Fleming discloses: "Creating a message to

send through the Internet is a very simple process......" (page 201, pgph 1). Fleming fails to

explicitly disclose: .....*said encoding means includes MIME-compatible encoding means.*

However, Hong et al disclose: "...program then converts each new note into a formal HTML

document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would

have been obvious to a person of ordinary skill in the art at the time of the invention to had

combined the teachings of Fleming and Hong et al, because Hong et al teach: ".....HTML

documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Regarding claim 6, which depends on claim 1, Fleming discloses: "Creating a message to

send through the Internet is a very simple process......" (page 201, pgph 1). Fleming fails to

explicitly disclose: .....*said encoding means includes means for creating a MIME-compatible*

file..... However, Hong et al disclose: "...program then converts each new note into a formal

HTML document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to

had combined the teachings of Fleming and Hong et al, because Hong et al teach: ".....HTML

documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Furthermore, Fleming discloses: "Creating a message to send through the Internet is a

very simple process......" (page 201, pgph 1). Fleming fails to explicitly disclose: *each of said*

authoring component cooperating with said encoding means such that a creation of said MIME

file.....is transparent to the user. However, Hong et al disclose: "...program then converts each new note into a formal HTML document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Fleming and Hong et al *such that a creation of said MIME file.....is transparent to the user,* because Hong et al teach: ".....HTML documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Regarding claim 7, which depends on claim 6, Fleming discloses: "Creating a message to send through the Internet is a very simple process......" (page 201, pgph 1). Fleming fails to explicitly disclose: *.....said decoding means includes means for concatenating a multipart MIME message.........* However, Hong et al disclose: ".....HTML documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Fleming and Hong et al, because Hong et al teach: ".....HTML documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Furthermore, Fleming discloses: "Creating a message to send through the Internet is a very simple process......" (page 201, pgph 1). Fleming fails to explicitly disclose: *each of said authoring component cooperating with said decoding means such that a concatenation of said multipart MIME message ... is transparent to the user.* However, Hong et al disclose: "...program then converts each new note into a formal HTML document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings

of Fleming and Hong et al *means such that a concatenation of said multipart MIME message ...*

is transparent to the user, because Hong et al teach: ".....HTML documents.....are then

concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Claims 17-19 are directed towards an electronic mail client for implementing the mail

client found in claims 3-7 respectively, and are similarly rejected.

Claims 23-24 are directed towards a method for implementing the mail client found in

claims 6-7 respectively, and are similarly rejected.

Response to Arguments

17.   Applicant's arguments filed 7/3/2000 have been fully considered but they are not

persuasive. The Applicant states regarding claims 2: "...The Examiner refers to the spell checker

in Outlook Express as an 'installable component' component......"(pg. 6, pgph. 2). It was well

known in the art at the time of the invention to install programs such as the spellchecker of

Outlook, as it is witnessed by the fact that applications such as e-mail program taught by

Fleming, and wordprocessors, spreadsheet, drawing programs, etc. as taught by Wolf et al, have

it installed.

Moreover, the Applicant states regarding claim 11: "...there is no evidence that the

stationary picture paster or the spell checker in Outlook Express communicates bidirectionally

with the encoding/decoding means......"(pg. 6, pgph. 3). The Examiner disagrees with this

statement, because the spellchecker taught by Fleming, communicates with Outlook

(*encoding/decoding means*) through the application of its various spellchecking features, and

Outlook communicates with the spellchecker by invoking its features. The Paster also interacts

with similarly with Outlook in order to paste an image into an e-mail message.

Further, the Applicant states regarding claim 12: "...there is no suggestion in the art of

record in the art of record to provide an authoring component with means for allowing a user to

create a read-only document......"(pg. 9, pgph. 1). The Examiner disagrees with this statement,

because Wolf et al teach enabling other application programs, such as database programs which

had the well known function to designate read only documents, so it would have been obvious to

one of ordinary skill at the time of the invention to had combine the teaching of Wolf et al with

email capability for sending document to recipients as taught by Fleming.

Moreover, The Applicant states regarding claims 14-20, 15-16: "...claim 13 has yet to be

rejected......"(pg. 7, pgph. 2, and pg. 9, pgph. 2). The Examiner disagrees with this statement,

because on page 9, item 9(claim 13), page 8 (claims 15-16), page 10 (claims 17-19) of the

previous Office Action respectively, the Examiner included the rejection for these claims. The

rejection of claim 20 are the same as claim 1. The rejections of claims 15-16 are the same as

claims 3-4.

Moreover, The Applicant states regarding claims 8-9: "...there is no evidence in any of

the cited art to provide 'a plurality of installable mailbox/browser components..'......"(pg. 8,

pgph. 2). The Examiner disagrees with this statement, because the Wolf teaches enabling a user

to display an e-mail in application programs—*mailbox/browser installable components* (col. 24,

lines 64-67), such as a full featured word processor, and provides suggestion to combine with

Fleming by placing the all the capabilities of a full featured application program (col. 14, lines

56-62).

Further, the rejections of claim 21 is the same as claim 1.

Moreover, The Applicant states regarding claim 13: ".....The Examiner states that the distinction between student and teacher .....is clearly incorrect......"(pg. 9, pgph. 4). The Examiner disagrees with this statement, because the Wolf teaches enabling a user to send an e-mail such as with the well known autosignature feature, identifying the sender (student or teacher) and enabling the recipient to reply to the sender (student or teacher).

Conclusion

I.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached on (703) 305-4713. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 308-9051, (for formal communications intended for entry)

Or:

- (703) 308-5403, (for informal or draft communications for discussion only, please

  label "**PROPOSED**" or "**DRAFT**").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

cbp

09/25/00

STEPHEN S. HONG
PRIMARY EXAMINER